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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,539	10/18/2001	Yushi Niwa	017661-0180	5077

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EXAMINER
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JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,539

Applicant(s)

YUSHI NIWA

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/1/05;10/27/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 1, 2005 has been entered.

Amendment filed September 1, 2005 has been acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, 6, 3, 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ronning (5,907,617).

Ronning discloses a data distribution as claimed having partial data preliminary distribution means for distributing partial data (via sample a software program 12) from a source (via an online system 42) to a user (10), the partial data comprising only a part

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of distribution data (via allowing to sample only a portion of the digital information), together with the attribute data including the price (inherent via program on sale or discounted) of the distribution data, to a storage region provided in each user side (col. 5, lines 1-24), partial data reproduction release means for when the indicates a decision to purchase the partial data distributed by the partial data preliminary distribution means or a remaining undistributed part of the distribution data, rendering reproducible the partial data except for the attribute data from the time of the indication at the earliest (col. 6, lines 9-51), remaining distribution data distribution means for upon receipt of a request from a user side for the distribution of the undistributed remaining part of the data corresponding to the partial data, distributing the remaining distribution data to the user who has requested the distribution of the remaining data (as illustrated in Figure 19; col. 11, lines 9-40), the remaining data distribution means further includes distribution interval regulation means that regulates the interval of the distribution (col. 2, lines 1-13), and the distribution data are distributed through a radio network (via exciting networks or online services).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2, 4, 7-10, 12, 13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning (5,907,617), in view Downs et al. (6,226,618).

Ronning discloses a data distribution as claimed having partial data preliminary distribution means for distributing partial data (via sample a software program 12), comprising a part of distribution data, together with the attribute data including the price (inherent via program on sale or discounted) of the distribution data, to a storage region provided in each user side (col. 5, lines 1-24), partial data reproduction release means for when the indicates a decision to purchase the partial data distributed by the partial data preliminary distribution means or a remaining undistributed part of the distribution data, rendering reproducible the partial data except for the attribute data from the time of the decision at the earliest (col. 6, lines 9-51), remaining distribution data distribution means for upon receipt of a request from a user side for the distribution of the undistributed remaining part of the data corresponding to the partial data, distributing the remaining distribution data to the user who has requested the distribution of the

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remaining data (as illustrated in Figure 19; col. 11, lines 9-40), the remaining data distribution means further includes distribution interval regulation means that regulates the interval of the distribution (col. 2, lines 1-13), and the distribution data are distributed through a radio network (via exciting networks or online services). Ronning further discloses verifying the purchase information, such as a credit card number, before executing an unlocking process the remaining data.

Although Ronning discloses a distribution center in response, to providing a credit card number at the purchase dialog box, provides the user with a password used for unlocking the application, and the user may then manually enter the password in the purchase window. Accordingly, steps 250 and 252 also involve generating the password from the serial number or key code. The serial number or key code provided by the user is processed using an identical decoding function, explained below, as on the user's machine, generating the same password that is stored in memory on the user's machine. The entered password is compared with the one stored in memory. If they match, the purchase is completed. However, Ronning fails to explicitly disclose payment judgment upon the receipt of a request.

Downs discloses the concept of delivering electronic content where deployment of an electronic distribution system provides the Digital Content Providers the ability to achieve fast settlement of payment through immediate sales reporting and electronic reconciliation as well as gain secondary sources of revenue through redistribution of content. Downs further discloses a payment ability judgment via a Clearinghouse that keeps a record of all transactions where a key exchange is cleared through the

Clearinghouse. This record allows for the metering of licensing authorization. The transaction record can be reported to responsible parties, such as, content proprietors or Content Provider(s), retailers, and others, on an immediate or periodic basis to facilitate electronic reconciliation of transaction payments and other uses. The distribution of data supports both point-to-point such as the Internet and broadcast distribution models such as broadcast television. The clearinghouse further maintains account balance in a billing subsystem and generates Reports using the information that are logged during End-User(s) purchase transactions.

From this teaching of Downs, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital data distribution of Ronning to include the monitoring of usage and charges of Downs in order to facilitate management of user's accounts.

### ***Response to Arguments***

7. Applicant's arguments filed September 01, 2005 have been fully considered but they are not persuasive. Applicant first argues that under the system of Ronning, the user already has all segments of the program and requires a "Key" to reassemble the program. The Examiner respectfully disagrees. Ronning stated instead of requiring a user to install a software or digital information distribution system and then sample other software programs, *a user may simply download each program to be sampled and/or purchased*. Thus, the system only download part of the program to be sampled, and Ronning further states that the system (online system) preferably maintains a secure

interface or protective envelope around the software program such that the user may not obtain a copy of the software program without first purchasing it. Applicant also acknowledged on page 8, that the user 10 may access the digital information or software program 12 in its entirety or *in part*.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lane discloses a system with the ability to download a limited functionality program object from one computer system to another, then to allow a user to view and interact but not control that object without first purchasing the object online.

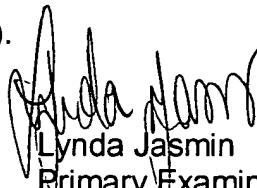
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Thursday Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627

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